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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte PHILIPPE BOULANGER,
SAMIRA BOUZIT-BENBERNOU, and FREDERIC TRESCAZES

Appeal 2016-007259
Application 13/622,737
Technology Center 2400

Before ERIC B. CHEN, KARA L. SZPONDOWSKI, and
PHILLIP A. BENNETT, *Administrative Patent Judges*.

SZPONDOWSKI, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's Non-Final Rejection of claims 1–13. We have jurisdiction under 35 U.S.C. § 6(b).

We REVERSE.

STATEMENT OF THE CASE

Appellants' invention is directed to an apparatus for sizing a parcel. Spec. 1. Claim 1, reproduced below, is illustrative of the claimed subject matter:

> 1. An automatic parcel sizing device comprising:
>
> a trihedral parcel support having three panels for receiving a parcel to be sized, each panel of which being disposed orthogonal to the other two panels and defining a vertex at an intersection point of said three panels,
>
> a unique fixed optical sensor for capturing an image of the parcel,
>
> and a processor unit in signal communication with said unique fixed optical sensor for determining from said captured image of the parcel the respective dimensions of three parcel edges which have a common vertex,
>
> wherein said vertex of the trihedral parcel support is disposed upside down such that, due to the gravity, the parcel is correctly placed regarding the trihedral parcel support in always a same location and said unique fixed optical sensor is placed vertically below said vertex and at a fixed distance from said vertex.

REJECTIONS

Claims 1, 3, 4, 6, and 10–13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dlugos (US 5,841,541; issued Nov. 24, 1998) and Prutu (US 2003/0075416 A1; published Apr. 24, 2003) ("Prutu").

Claim 2 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dlugos, Prutu, and Horhann et al. (US 2006/0112023 A1; published May 25, 2006) ("Horhann").

Claims 5 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dlugos, Prutu, and Gunn (US 4,024,380; issued May 17, 1977).

Claims 8 and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Dlugos, Prutu, and Wang et al. (US 2009/0039167 A1; published Feb. 12, 2009) ("Wang").

ANALYSIS

The Examiner finds Dlugos teaches most of the limitations in claim 1, except "Dlugos does not explicitly disclose parcels to be placed on the parcel support platform so that the parcel is stable with respect to gravitational force." Non-Final Act. 5. The Examiner, therefore, relies on Prutu, as teaching locating "the approximately center of gravity" of the parcel. *Id.*, citing Prutu ¶ 12. The Examiner further finds:

> tilting the supporting structure so that the weight of the parcel is supported by three side panels, as opposed to just one panel, is such a minor modification to the combination of Dlugos and Prutu that would have been obvious to a person of ordinary skill in the art at the time the invention was made.

Id. at 3–4; Ans. 10. The Examiner finds one of ordinary skill in the art would be motivated to combine Dlugos and Prutu, and to make the "minor improvement" in order "to facilitate parcel measurement, identification, sorting and delivery." Non-Final Act. 6; Ans. 10.

Appellants contend "Dlugos teaches positioning the emitter scanners 34, 36 above the point where the upright adjacent walls 16, 22 meet the platform 12." App. Br. 14. Appellants argue "if the emitter scanner 34 were vertically below the point where the upright adjacent walls 16, 22 meet the platform 12, the CPU 32 would fail to correctly calculate the dimensions of

the parcel P1 along the calibrated reflective strips 14, 20." *Id.* at 13. Appellants further contend "the Examiner fails to articulate any reason for modifying the proposed combination of Dlugos and Prutu absent impermissible hindsight." *Id.* at 10.

We are persuaded by Appellants' arguments. Figure 1 of Dlugos is reproduced below:

FIG. 1

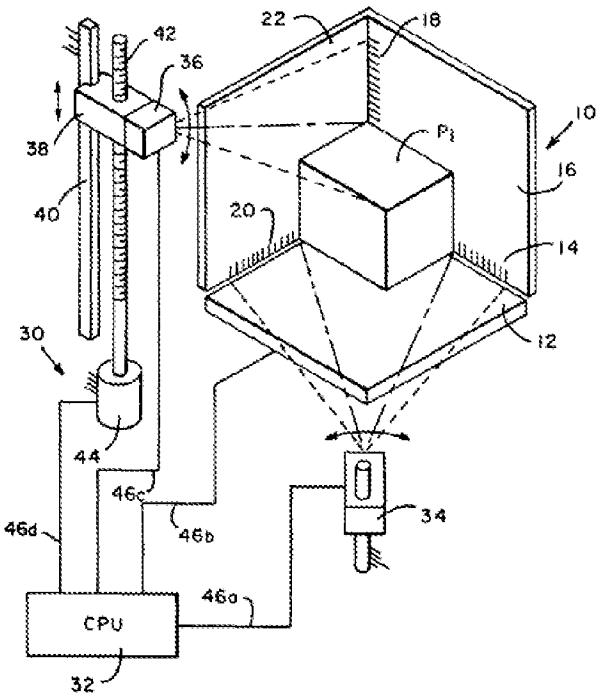

Figure 1 depicts a system using two separately located emitter scanners **34** and **36** to determine the linear measurements of a parcel, P_1. Dlugos col. 4, ll. 65–67. Figure 1 further depicts platform **12**, on which parcel P_1 is placed, and adjacent walls **16** and **22**. Dlugos col. 5, ll. 9–12, 16–20. At their base, adjacent walls **16** and **22** have a calibrated reflective

strip **14** and **16**. Dlugos col. 5, ll. 21–24. Where walls **16** and **22** meet to form a right angle is another calibrated reflective strip **18**. Measurement of parcel P_1 is accomplished by emitting a beam of light from each of emitter scanners **34** and **36**. Dlugos col. 5, ll. 40–42. Light that is reflected back to each of the emitter scanners from the calibrated markings of the calibrated reflective strips **14**, **18**, and **20** is counted and used to calculate the parcel dimensions. Dlugos col. 5, ll. 42–55.

The Examiner finds sensor **34** in Figure 1 of Dlugos is located "below the vertex of the package" and emitter scanner **36** "can be moved vertically up and down so that it can be moved to be placed below vertex." Ans. 10; Non-Final Act. 4. However, the Examiner states "Dlugos' disclosure is silent about the location of emitter scanner with respect to platform 12" so "[t]here is no requirement that emitter scanner 34 has to be placed above the platform." Ans. 10–11.

We do not agree with the Examiner that emitter scanner **34** and/or emitter scanner **36** are below the vertex of walls **16** and **22** and platform **12**. While it is true that Dlugos does not explicitly describe the position of the emitter scanners **34** and **36** with respect to platform **12**, Dlugos does describe that "emitter scanner **34** is mounted at a height that will allow emitter scanner **34** to emit a beam of light toward the calibrated reflective strips **14** and **20** and to receive a reflection back from the beam." Dlugos col. 5, ll. 61–64. With respect to emitter scanner **36**, Dlugos describes "the sensor would be placed high enough above the flat surface of the measurement field so as to detect all of the visible calibration marks on the two axis of measurement." Dlugos col. 4, ll. 31–34; *see also* Dlugos col. 4, ll. 55–60 ("[t]he scanner is . . . further positioned at a height where it can scan and

count the visible lines that will constitute the length and width of the package dimensions as well as rotate upward to calculate the height of the package"). Figure 1 depicts both emitter scanners **34** and **36** on a surface and emitting beams of light toward the calibrated reflective strips **14**, **18**, and **20**. Presumably, subsystem **10** is also on a surface, and not floating in the air. The Examiner does not explain, nor do we discern, how emitter scanner **34** or emitter scanner **36** can be placed below the vertex of walls **16** and **22** and platform **12**, and still be able to detect the visible calibration marks on the appropriate axis of measurement.

However, even assuming emitter scanners **34** and **36** *are* below the vertex of walls **16** and **22** and platform **12**, the Examiner proposes modifying Dlugos by tilting the supporting structure so the weight of parcel P_1 is supported by walls **16** and **22** and platform **12**, as opposed to just platform **12**. Ans. 10. As stated in *KSR Int'l. Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), "'[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"' (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

We see no difference between conclusory statements that this modification is a "minor modification" (Non-Final Act. 3–4) or a "minor improvement" (Ans. 10) and stating that these changes are "common sense," which, without more, is insufficient to support an obviousness analysis. *See In Re Van Os*, 844 F.3d 1359, 1361 (Fed. Cir. 2017) ("obviousness findings 'grounded in 'common sense' must contain explicit and clear reasoning'") (citation omitted); *Mintz v. Dietz & Watson*, 679 F.3d 1372, 1377 (Fed. Cir.

2012) ("The mere recitation of the words 'common sense' without any support adds nothing to the obviousness equation.").

Given the proposed modification, as well as the thin reasoning proffered for the modification ("to facilitate parcel measurement, identification, sorting and delivery" Ans. 3), we conclude that the Examiner improperly used the claims of the instant application as a guide in constructing a system. *See Plantronics v. Aliph, Inc.*, 724 F.3d 1343, 1354 (Fed. Cir. 2013) ("Where, as here, the necessary reasoning is absent, we cannot simply assume that 'an ordinary artisan would be awakened to modify prior art in such a way as to lead to an obviousness rejection.' It is in such circumstances, moreover, that it is especially important to guard against the dangers of hindsight bias." (citation omitted)); *see also W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1552 (Fed. Cir. 1983) ("The result is that the claims were used as a frame, and individual, naked parts of separate prior art references were employed as a mosaic to recreate a facsimile of the claimed invention. At no point did the district court, nor does Garlock, explain why that mosaic would have been obvious to one skilled in the art . . . ."). An analysis infected with impermissible hindsight cannot form the basis of an obviousness conclusion. *See KSR*, 550 U.S. at 421 ("A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon *ex post* reasoning.")

Accordingly, the Examiner's findings lack adequate reasoning, with rational underpinning, to show sufficiently that a person of ordinary skill in the art would have had reason to combine the teachings of Dlugos and Prutu and then to make the further required modification of tilting the supporting

structure, which accounts for each limitation in the claim. Because we agree with at least one argument advanced by Appellants, we need not address Appellants' remaining arguments.

We, therefore, do not sustain the Examiner's rejection of independent claim 1 and dependent claims 2–13.

DECISION

For the above reasons, the Examiner's rejection of claims 1–13 is reversed.

REVERSED